

1      **REMARKS:**

2      In the Office Action, the Examiner notes that claims 1-9 are pending in the application  
3      and that claims 1-9 are rejected. In the view of the amendments submitted herein, Applicant  
4      respectfully submits that the Examiner's rejections are overcome.

5                   **I.**

6                   **Formalities**

7      The Examiner objects to the drawings on the grounds that ball bearings and the cover  
8      positioned on the second surface were not shown in the drawings. Submitted herewith are  
9      replacement figures 2 and 4 which show these features of the invention. See reference character  
10     22 added to the left of Figure 2, and reference character 29 added to Figure 4. The replacement  
11     drawings add no new matter because these features were disclosed within the application as filed.  
12     The cover positioned on the second surface is disclosed at page 3, lines 22-23. The ball bearings  
13     are disclosed at page 4, lines 5-7. The Specification has been amended to add reference  
14     character 29 to designate the ball bearings.

15     The Examiner further objects to the drawings on the grounds reference character "18" has  
16     been used in the Specification to designate the *foot engaging member* and the *sealing member*.  
17     Applicant has amended the Specification to correct this typographical error; the reference  
18     character for the foot engaging member has been corrected to 12. The sealing member is  
19     correctly identified as reference character 18.

20                   **II.**

21                   **Claim Rejections - 35 USC § 103**

22     **A.      Claims 1-9 - Summary of Examiner's Grounds for Rejection**

23     Examiner rejects claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over O'Dell  
24     (US D477,376) in view of Outlaw (US 6,422,872) and Krive (US 4,629,181). The Examiner  
25     states, with regard to claim 1, that O'Dell shows a rotatable base for training proper foot  
26     placement and movement of the batter; as shown in Figures 1 and 7. The Examiner notes that  
27     O'Dell's design patent does not show the shifting of weight so that the majority of the batter's  
28     weight is supported by the first foot, and swinging the bat, and simultaneously rotating the first  
29     foot on the baseball training device but not moving the first foot off of the training device so that  
30     the batter's hips rotate in the same direction as the bat, and completing the swing. However,  
31     according to the Examiner, these are well known steps that a batter ordinarily takes in order to  
32     achieve the optimum results. In support of this claim, the Examiner cites column 1, lines 10-34  
33     of Outlaw. The Examiner concludes it would have been obvious to apply these steps when  
34     utilizing the training device of O'Dell.

1       The Examiner further cites Krive, which discloses a multi-directional movement leg  
2 exerciser, regarding the specific details for forming the rotatable base. According to the  
3 Examiner, Krive shows an integrated pivoting unit comprising a first flange (42) and a second  
4 flange (40) in facing relation, the first flange pivotally attached at its center to the center of the  
5 second flange, where a bearing housing is defined between the first flange and the second flange,  
6 and where a sealing member 44 encircles the bearing housing. The Examiner concludes it would  
7 have been obvious to modify the rotatable base of O'Dell to the base would include the same  
8 specific features of Krive's rotatable base, the motivation being so the user is able to freely shift  
9 his body weight on his or her first/rear foot.

10      The Examiner rejects claim 2, taking Official Notice of the use of O-rings in the bearing  
11 art, and claiming that it would have been obvious to include a rubber O-ring around the bearing  
12 assembly of Krive to "protect the ball bearings from damage."

13      The Examiner rejects claim 3, taking Official Notice of the equivalence of screws and  
14 rivets in the fastening art and that the selection of any of these known materials would be within  
15 the level of ordinary skill in the art.

16      The Examiner rejects claim 4, noting that O'Dell shows the foot-engaging member to be  
17 round.

18      The Examiner rejects claim 5, stating that, as best seen from the figures, "O'Dell shows  
19 the upper and lower members to the same size and shape."

20      Regarding claim 6, the Examiner notes that O'Dell is silent regarding the exact size of the  
21 training device, but notes that it appears that the base of O'Dell falls within the claimed range.

22      Regarding claim 7, the Examiner's conclusion is based upon the same grounds as for  
23 claim 1.

24      Regarding claim 8, the Examiner's conclusion is based upon the same grounds as for  
25 claim 5.

26      Regarding claim 9, the Examiner's conclusion is based upon the same grounds as for  
27 claim 6.

## 22      B.     Claims 1-9 - Applicant's Reply to Examiner's Rejections

### 23      1.     **The Examiner Has Not Established A Prima Facie Case of Obviousness for 24           Claim 1 Because The Cited References Fail to Provide a Suggestion or 25           Motivation for One Skilled in the Art to Combine the References**

26      "To establish a *prima facie* case of obviousness, three basic criteria must be met. First,  
27 there must be some suggestion or motivation, either in the references themselves or in the  
knowledge generally available to one of ordinary skill in the art, to modify the reference or to

1 combine reference teachings. Second, there must be a reasonable expectation of success.  
2 Finally, the prior art reference (or references when combined) must teach or suggest all the claim  
3 limitations. The teaching or suggestion to make the claimed combination and the reasonable  
4 expectation of success must both be found in the prior art and not based on applicant's  
disclosure." MPEP §2142; *In re Vaeck* (Fed. Cir. 1991) 20 USPQ2d 1438.

5 "Obviousness cannot be established by combining the teachings of the prior art to  
6 produce the claimed invention, absent some teaching suggestion or incentive supporting the  
7 combination." *In re Geiger* (Fed. Cir. 1987) 2 USPQ 2d 1276, 1278. "The factual inquiry  
8 whether to combine references must be thorough and searching. It must be based on objective  
evidence of record." *In re Lee* (Fed. Cir. 2002) 61 USPQ 2d 1430, 1433. The mere fact that  
9 references can be combined or modified does not render the resultant combination obvious  
unless the prior art also suggests the desirability of the combination. *In re Mills* (Fed. Cir. 1990)  
10 16 USPQ2d 1430, 1432. The suggestion to combine the references must not require substantial  
11 reconstruction or redesign of the differences to arrive at the claimed invention, nor require a  
change in the basic principles by which an invention is designed to operate. *In re Ratti* (CCPA  
12 1959) 123 USPQ 349, 352.

13 In this case, Applicant respectfully submits that the Examiner has not met this burden.  
14 Regarding claim 1, the Examiner states "The aforementioned are well known steps that a batter  
ordinarily takes in order to achieve the optimum batting results. Outlaw teaches these steps (see  
15 column 1, lines 10-34). In view of Outlaw it would have been obvious to also apply these well-  
known step when utilizing the training device of O'Dell et al." However, claim 1 includes the  
16 following limitation:  
17

18 "swinging the bat, and simultaneously rotating the first foot on the baseball  
19 training device but not moving the first foot off of the baseball training device so  
that one's hips rotate in the same direction as the bat"

20 However, the referenced portion of Outlaw *says nothing* about movement of the rear foot  
(the "first foot" in the subject application), including rotation. The emphasis of the referenced  
21 portion of Outlaw is on movement of the *front foot*, also referred to as the "stride foot." To the  
22 extent the Examiner relies upon O'Dell to provide the limitations missing from Outlaw,  
23 Applicant respectfully submits that the design patent of O'Dell merely refers to "proper foot  
placement and movement for batters" and says nothing about the coordinated movements of  
24 swinging the bat, rear foot rotation and not moving the first foot off of the device. Any  
25 conclusions that the drawings of O'Dell teach such movements would be based upon pure  
speculation.  
26

27 Therefore, the prior art references relied upon by the Examiner fail to teach all of the

1 limitations of claim 1. Given that claims 2-6 depend upon claim 1, the rejection of those claims  
2 is not well taken because the underlying base claim is not obvious.

3           **2. The Examiner's Rejection of Claim 2 for Obviousness Is Procedurally**  
4           **Defective Because The Examiner Has Not Identified Specific Data Sufficient**  
5           **to Demonstrate that the Use of O-Rings to Protect Ball Bearings is Well**  
          **Known in the Art**

6           The Examiner notes that Krive is silent with respect to the use of a rubber O-ring. The  
7           Examiner takes Official Notice of the use of O-rings in the bearing art and states "it would have  
8           been obvious to include a rubber O-ring around the bearing assembly of Krive, the motivation  
being to protect the ball bearings from damage."

9           The Applicant respectfully submits that the Examiner's rejection is procedurally  
10          defective. As stated in MPEP 706.02(j):

11          After indicating that the rejection is under 35 U.S.C. 103, the examiner should set  
          forth in the Office action:

12          (A) the relevant teachings of the prior art relied upon, preferably with reference to  
          the relevant column or page number(s) and line number(s) where appropriate,  
13          (B) the difference or differences in the claim over the applied reference(s),  
          (C) the proposed modification of the applied reference(s) necessary to arrive at the  
          claimed subject matter, and  
14          (D) an explanation why one of ordinary skill in the art at the time the invention  
          was made would have been motivated to make the proposed modification.

15          The Examiner has provided no reference in support of her position that the use of O-rings  
16          to protect ball bearings is well known in the art. It may be assumed, in the absence of references  
17          provided by the Examiner, that the Examiner is relying upon her own personal knowledge.

18          However, pursuant to 37 C.F.R. Section 1.104(d)(2):

19          When a rejection in an application is based on facts within the personal  
          knowledge of an employee of the Office, the data shall be as specific as possible,  
20          and the reference must be supported, when called for by the applicant, by the  
          affidavit of such employee, and such affidavit shall be subject to contradiction or  
          explanation by the affidavits of the applicant and other persons.

22          Applicant respectfully submits that the Examiner has not provided specific data in  
support of her position sufficient to establish, *prima facie*, that it would have been obvious to one  
23          skilled in the art to use an O-ring to protect ball bearings from damage. "Assertions of technical  
facts in areas of esoteric technology must always be supported by citation to some reference work  
24          recognized as standard in the pertinent art . . ." *In re Pardo* (CCPA 1982) 214 USPQ 673, 677.  
In this case, the Examiner has issued a rejection based upon what she asserts was known in the  
25          bearing art without providing any reference or standard upon which to evaluate the validity of the  
26          rejection.

1           Accordingly, Applicant respectfully requests the Examiner to either support the reference  
2 with an Examiner's affidavit pursuant to 37 C.F.R. Section 1.104(d)(2) or to withdraw the  
3 obviousness rejection.

4           **3. The Amendment to the Claims Eliminates the Grounds for Rejection**

5           Applicant respectfully submits that the claim amendments provided herein eliminate the  
6 ground for the claim rejections. Independent claims 1 and 7 have been amended to change the  
7 words "sealing member" to "friction inducing member". Claim 2 has been amended to identify  
8 the friction inducing member as a rubber O-ring. The Examiner's rejection focuses on the  
9 function of the sealing member 18 to protect the ball bearings, which function is identified within  
10 the specification at page 4 line 27 through page 5 line 1. However, the specification identifies a  
11 second function of the sealing member, which is stated at page 5 lines 1-5:

12           Sealing member 18 also adds additional friction so that flanges 28 do not freely  
13 spin, thereby causing the sensation of rotating the foot on the device to resemble  
14 to a greater degree the sensation of rotating the rear foot on the ground itself. Yet,  
15 when weight is placed on the device and the rear foot rotated, the flanges 28 spin  
16 in such a manner as to convey to the batter proper batting posture and technique.  
17 Therefore, the specification, as filed, discloses the independent function of the sealing member to  
18 induce friction in the spinning of the flanges with respect to one another. Applicant respectfully  
19 submits that none of the references cited by the Examiner disclose or suggest the limitation added  
20 by the amendment. The amendments to the underlying base claims, independent claims 1 and 7,  
21 eliminate the grounds for rejection of the dependent claims.

22           It should also be noted that claim 7 is amended to correct a typographical error. The  
23 words "a sealing member" at page 7 line 16 were inadvertently placed within the claim. The  
24 amendment to the claim corrects the typographical error.

25           **III**

26           **Conclusion**

27           Applicant respectfully submits that this submission is fully responsive to the April 1,  
28 2004 Office Action, and these claims are in condition for allowance. The issuance of a Notice of  
Allowance at an early date is therefore requested.

If the Examiner believes a telephone conference would expedite prosecution of this  
application, please telephone the undersigned at (661)395-1000.

Respectfully submitted,

By   
JAMES M. DUNCAN  
Reg. No. 44,664